

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILBERT P. HYATT

Appeal No. 98-1913
Control 90/001,869¹

HEARD: FEBRUARY 8, 1999

Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

¹ Reexamination proceeding for U.S. Patent No. 4,739,396, issued April 19, 1988, of Control No. 90/001,869, filed October 24, 1989, based on Application 06/425,136 filed September 27, 1982; which is a continuation-in-part of Application 05/860,278, filed December 13, 1977, now Patent No. 4,471,386, issued September 11, 1984; which is a continuation-in-part of Application 06/169,257, filed July 16, 1980, now Patent No. 4,435,732, issued March 6, 1984; which is a continuation-in-part of Application 05/101,881, filed December 21, 1970, now abandoned; which is a continuation-in-part of Application 05/134,958, filed April 19, 1971, now abandoned.

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DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-90 in the reexamination of United States Patent No. 4,739,396, which constitute all the claims in the reexamination proceeding.

The invention pertains to projection display apparatus, and particularly apparatus utilizing liquid crystal control elements and to flat panel displays.

Representative claims 5 and 43 are reproduced as follows:

5. A projection television display system comprising:

an illumination source generating source illumination;

an electrical control circuit generating an electrical control signal related to a moving display image, wherein said control circuit includes a television receiving circuit for receiving a television signal and an output circuit for generating the electrical control signal in response to the received television signal;

an illumination control device controlling the source illumination from said illumination source to generate a television display image in response to the electrical control signal generated with said output circuit, the illumination control device being a flat panel display having a two-dimensional coincidentally selected array of display cells; and

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a projector generating a projected television image by projecting the television display image generated with said illumination control device.

43. A flat plane television system, said flat plane television system comprising:

an illumination source generating source illumination;

a television receiver generating a television video signal in response to a transmitted television signal; and

a flat plane electro-optical display controlling reflection of the source illumination to generate a television image under control of the television video signal generated with said television receiver, the electro-optical display having a two-dimensional coincidentally selected array of display cells.

THE REFERENCES

The examiner relies on the following references:

Ferguson et al. (Ferguson)	3,401,262	Sep. 10, 1968
Heilmeier et al. (Heilmeier)	3,499,112	Mar. 03, 1970
Hanlon	3,569,614	Mar. 09, 1971
Marie	3,588,324	June 28, 1971
Roth	3,760,096	Sep. 18, 1973
Fischer	3,840,695	Oct. 08, 1973

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Koda et al. (Koda) 1974	3,824,003	Jul. 16,
de Quervain et al. (de Quervain) 1975	3,895,866	Jul. 22,
Ernstoff et al. (Ernstoff '968) 1977	4,006,968	Feb. 08,
Ernstoff et al. (Ernstoff '219) 1978	4,090,219	May 16,
Jacobson et al. (Jacobson) 1978	4,127,322	Nov. 28,
Scheffer 1980	4,239,349	Dec. 16,
Hyatt (Hyatt '732) 1984	4,435,732	Mar. 06,
Hyatt (Hyatt '385) 1984	4,471,385	Sep. 11,
Taguchi (Japanese laid-open Application) 1977	52-77699	June 30,

V. K. Zworykin et al. (Zworykin), Television, 2nd edition, John Wiley & Sons, Inc., New York, 1954, pages 266-273.

Lechner et al. (Lechner), "Liquid Crystal Matrix Displays," Proceedings of the IEEE, Vol. 59, No. 11, November 1971, pages 1566-1579.

Robertson, "Projection Television," Wireless World, Vol. 82, No. 1489, September 1976, pages 47-52.

THE REJECTIONS

The examiner entered the following rejections:

1. Claims 5, 9-14, 32-36, 42-49, 56, 59, 60, 69-72, 76-80, 84, 87 and 88 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement.

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2. Claims 1-4, 6-8, 15-31, 37-41, 50-55, 57, 58, 61-68, 73-75, 81-83, 85, 86, 89 and 90 stand rejected under 35 U.S.C. § 112, first paragraph, as broader than the disclosure.

3. Claims 2-90 stand rejected under 35 U.S.C. § 305 as broader than the original patent claims.

4. Claims 2-90 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description.

5. Claim 2 stands rejected under 35 U.S.C. § 305 as broader than the original patent claim.

6. Claims 57 and 58 stand rejected under 35 U.S.C. § 112, first paragraph, as containing new matter.

7. Claims 5-7, 18, 20, 39-41, 84 and 85 stand rejected under 35 U.S.C. § 102 as anticipated by Marie.

8. Claims 5-7, 18, 20, 39-41, 84 and 85 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marie taken with Lechner or Heilmeier in view of Zworykin.

9. Claims 5, 7, 8, 19, 32, 39-41, 43, 48, 49 and 52 stand rejected under 35 U.S.C. § 102 as anticipated by Jacobson.

10. Claims 5, 7, 8, 10, 19, 32, 39-41, 43, 48, 49 and

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52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jacobson taken with Lechner or Heilmeier.

11. Claims 5, 7, 39, 40, 42 and 52 stand rejected under 35 U.S.C. § 102 as anticipated by Robertson.

12. Claims 10, 32, 43, 48 and 49 stand rejected under 35 U.S.C. § 102 as anticipated by Jacobson, figures 5 and 6.

13. Claims 56, 57, 74 and 75 stand rejected under 35 U.S.C. § 103 as unpatentable over Robertson in view of Marie, Scheffer, Jacobson and Ernstoff '968.

14. Claims 56, 57, 74 and 75 stand rejected under 35 U.S.C. § 103 as unpatentable over Robertson, Marie, Scheffer and/or Jacobson in view of Ernstoff '968.

15. Claim 58 stands rejected under 35 U.S.C. § 103 as unpatentable over Jacobson in view of Marie, Scheffer and Ernstoff '968.

16. Claim 86 stands rejected under 35 U.S.C. § 103 as unpatentable over Roth in view of Heilmeier '112.

17. Claim 38 stands rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement.

18. Claims 9, 11-15, 17, 22, 24, 28, 33, 44, 59 and 87 stand rejected under 35 U.S.C. § 103 as unpatentable over

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Roth in view of Heilmeier '112 and Lechner.

19. Claims 1, 3, 16, 19, 23, 25, 26, 29-31, 34-37, 45-47, 50, 51, 54, 67, 72, 77, 79 and 82 stand rejected under 35 U.S.C. § 103 as unpatentable over Roth in view of Heilmeier '112, Lechner, Taguchi and Fergason.

20. Claims 4, 55 and 83 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Heilmeier '112, Taguchi, Fergason and Lechner.

21. Claims 21, 27 and 28 stand rejected under 35 U.S.C. § 103 as unpatentable over Roth.

22. Claims 52, 61, 68, 76 and 80 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Lechner.

23. Claims 60, 65 and 69 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Lechner.

24. Claim 53 stands rejected under 35 U.S.C. § 103 as unpatentable over Hanlon and Fischer in view of Lechner, Taguchi and Fergason.

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25. Claims 64 and 67 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Ferguson.

26. Claims 62, 66, 71-73 and 77-79 stand rejected under 35 U.S.C. § 103 as unpatentable over Hanlon, Fischer, Lechner and Ferguson.

27. Claims 74, 75, 81, 84, 85 and 88-90 stand rejected under 35 U.S.C. § 103 as unpatentable over Marie in view of Lechner and Ferguson.

28. Claim 2 stands rejected under 35 U.S.C. § 103 as unpatentable over Lechner in view of de Quervain and Ferguson.

29. Claims 1 and 2 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner, de Quervain and Ferguson.

30. Claims 3, 9, 11-17, 19, 22-26, 28-40, 42, 44-50, 51, 52, 54, 56, 59, 84, 85 and 87-90 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner, Roth and Heilmeier.

31. Claims 4, 55 and 83 stand rejected under the

judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Hanlon.

32. Claims 5-8, 18, 20, 41, 42, 74, 75, 84 and 85 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Marie.

33. Claims 8 and 43 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Jacobson or Marie.

34. Claim 10 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner.

35. Claims 21, 27 and 28 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Roth.

36. Claims 9, 74, 75, 81, 82 and 88 stand rejected under the judicially created doctrine of obviousness-type

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double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Marie.

37. Claims 52, 57, 58, 64, 67, 68 and 76 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Fischer.

38. Claims 53, 60-63, 65, 66, 69-73 and 77-80 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Fischer and Lechner.

39. Claim 86 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Roth and Heilmeier.

40. Claims 1, 3, 5-11, 15, 18, 20, 41-43, 74, 75, 81, 82, 84, 85 and 88 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie.

41. Claims 1, 3, 5, 7-11, 15, 18, 52, 53, 57, 58, 60-

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73 and 76-80 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer and Lechner.

42. Claim 2 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer and Lechner and further in view of de Quervain.

43. Claim 2 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie and further in view of de Quervain.

44. Claims 4, 55 and 83 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Hanlon.

45. Claims 12-40, 42, 44-52, 54, 56, 59 and 84-90 stand rejected under the judicially created doctrine of

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obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Roth, Lechner and Heilmeier.

46. Claims 1-90 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385.

47. Claims 1-90 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732.

48. Claims 1-90 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Hyatt '385 and/or Hyatt '732.

We note that the positions of the examiner and appellant are extensively set forth in the record. The rejections are set forth in Appendix A to the answer [144 pages]. The initial appeal brief raised all the questions considered relevant by appellant [185 pages]. The examiner's answer extensively responded to appellant's arguments on a point by point basis [168 pages]. Appellant filed a first reply brief which addressed the examiner's position in the

answer and raised questions about the law of reexamination [54 pages]. The examiner responded with a supplemental answer which again responded to appellant's reply brief on a point by point basis [20 pages]. Finally, appellant filed a supplemental reply brief which argued many of the same issues one more time [95 pages]. As can be seen, the briefs and answers in this appeal are contained in over 600 pages of materials. Since the record of the positions of the examiner and appellant are lengthy and substantially complete, we will not repeat these positions in this decision. Instead, we will incorporate arguments of appellant or the examiner where possible by making reference to the briefs and the answers for the respective details thereof.

OPINION

At the outset we note that appellant asks that all rejections be reversed and the reexamination be dismissed on the ground that the reexamination was improperly granted, citing

In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997) and In re Recreative Technologies Corp., 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996). According to

appellant, there is no substantial new question of patentability raised in the reexamination request because the prior art cited by the requester is no better than the prior art considered by the examiner during the original examination and the requester did not provide a comparative analysis of the new references and the references considered by the examiner in the original examination leading to the patent which is the subject of this reexamination [reply brief and supplemental reply brief].

Portola and Recreative Technologies basically hold that an issue considered during the prosecution leading to a patent cannot be the sole basis for a reexamination of the patent. The court made it clear that the Patent and Trademark Office (PTO) lost jurisdiction of the case when there ceased to be any substantial new questions of patentability. The determination that there was no substantial new question of patentability was clear on its face. There was no factual dispute before the court to complicate its ruling.

On the other hand, we are faced with a reexamination proceeding in which substantial amendments have been made to at least some of the claims, and there are art rejections

pending against the claims which were not considered during the course of the original prosecution of the patent. Thus, appellant's request that we dismiss this reexamination on the ground that the PTO lacked jurisdiction to grant the reexamination request because there was no substantial new question of patentability is not supported by the record in this case and is factually distinguishable from the holdings in Portola and Recreative Technologies. Although we accept the proposition that these cases preclude arguing the exact same issues on reexamination which were argued during the original prosecution, we are not prepared to extend these cases to issues which were not clearly argued during the original prosecution.

Appellant's request that we dismiss this reexamination also asks that we independently consider the merits of the new prior art cited by the requester and make our own determination as to whether a substantial new question of patentability has been raised. In other words, appellant argues that the new prior art cited by the requester was not, in fact, any better than the prior art considered during the original examination. Appellant essentially asks us to rule

that the reexamination request should never have been granted and to dismiss this reexamination at this time. Such a request requires that we quantify the various rejections made in the reexamination proceeding and determine whether any rejections in this proceeding are quantifiably better than rejections that were considered during prosecution of the original patent. This, we decline to do.

The authority to determine whether a substantial new question of patentability is raised is given to the Commissioner [35 U.S.C. § 303(a)]. A determination by the Commissioner that no substantial new question of patentability has been raised in the request is final and nonappealable [35 U.S.C. § 303(c)]. In this proceeding, however, we have the granting of the request. The question appellant poses is what remedy is available to him to challenge the Commissioner's decision to grant the reexamination request. In our view, we do not have the authority to rule on whether the Commissioner properly granted the request for reexamination. Decisions of the Commissioner or his designate must be corrected by petition submitted under the provisions of 37 CFR §§ 1.181 to 1.183. The decision of the Commissioner granting the

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reexamination request should have been immediately challenged by petition to the Commissioner or by other appropriate review. Note In re Hengehold, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

Appellant's request for dismissal of this reexamination proceeding also asserts that the requester's showing in support of the request as well as the examiner's findings that a substantial new question of patentability had been raised were legally insufficient. Although we do not have jurisdiction of this issue for reasons just discussed, we would not agree anyway that the Board must dismiss a reexamination proceeding based solely on the quality of the presentation as to whether a substantial new question of patentability has been raised. For purposes of granting the request, it is sufficient that as part of the determination of whether a substantial new question of patentability has been raised that the examiner determines that prior art which was not of record in the patented file constitutes prior art which potentially renders the claimed invention unpatentable. We also do not agree with appellant that the burden is on the requester to "prove" that the newly cited references are

better than the references of record. Whether one reference is "better" than another is based on many subjective considerations which only become apparent when the prior art is considered as a whole. At any rate the decision that a substantial new question of patentability has been raised is made by the Commissioner and not by the requester. The Commissioner would always have the authority to buttress a requester's findings with his own findings in support of the decision to grant the reexamination. At any rate, the examiner in this proceeding has specifically stated that the new references cited in this reexamination request are better than the Fergason reference cited in the patent [supplemental answer, page 3]. Although appellant disagrees with this assertion of the examiner, an appeal is not the proper mechanism for challenging an improper decision to order a reexamination. There is sufficient evidence to support the granting of the reexamination request here. Moreover, any defect in declaring the reexamination will be cured if the ultimate decision on reexamination is consistent with the statute. In re Hiniker Co., 150 F.3d 1362, 1366-67, 47 USPQ2d 1523, 1527 (Fed. Cir. 1998). On the facts of this case, we

hold that the reexamination request was properly granted by the examiner based on the new evidence brought forward by the requester. Therefore, all of appellant's arguments with respect to the propriety of granting the reexamination request are now considered to be irrelevant to this proceeding.

Even though we hold that the reexamination request was properly granted here, appellant is correct to argue that issues which were clearly resolved or apparently resolved during the original prosecution should not be asserted or reasserted as part of the reexamination proceeding. Portola and Recreative Technologies certainly support the proposition that a patentee should not have to argue issues which were clearly part of the original prosecution or that were apparently part of the original prosecution. We will consider this aspect of the issue with respect to each of the rejections considered below.

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the examiner as support for the prior art rejections. We have, likewise, reviewed and taken

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into consideration, in reaching our decision, the appellant's arguments set forth in the briefs, the declarations filed by appellant, along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers. As a result of this careful review of the record, we decide the various rejections as set forth below.

Appellant has nominally indicated that the claims do not stand or fall together, but he has not specifically argued the limitations of each of the claims. For the most part, appellant's arguments are directed to the claims as groups correlated to the various rejections listed above. To the extent that appellant has properly argued the reasons for independent patentability of specific claims, we will consider such claims individually for patentability. To the extent that appellant has made no separate arguments with respect to some of the claims, such claims will stand or fall as a group.

Note In re King,

801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

REJECTION 1

Rejection 1 corresponds exactly to a new ground of rejection entered by the Board in a previous appeal involving this reexamination proceeding [Appeal 92-0829, decided August 26, 1993]. The new ground of rejection was based on a lack of enablement under the first paragraph of 35 U.S.C. § 112 for claims 5, 9-14, 32-36, 42-49, 56, 59, 60, 69-72, 76-80, 84, 87 and 88. The Board based its decision on the inadequacy of the disclosure of the patent under reexamination to support claims drawn to television and moving picture limitations [previous decision, pages 22-24]. The Board noted that since the earlier Hyatt patent 3,986,022 (Hyatt '022) did not support these claims of the reexamination proceeding, the burden was on appellant to establish that the skill of the artisan had increased sufficiently between the filing date of Hyatt '022 and the filing date of the patent under reexamination here to provide enablement to a previously non-enabling disclosure.

Appellant asserts that the rejection is based upon a misconception of the disclosed pulse width modulation technique. Appellant also argues that the claims do not recite the alleged deficient subject matter and that the

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incorporated Lechner article would have provided an enabling disclosure for the claimed invention [brief, pages 52-53]. Appellant also argues that this issue has been improperly asserted as part of a reexamination proceeding [reply briefs].

We will not sustain this rejection. In our view, the Board in its previous decision should not have concluded that the specification of the patent under reexamination is deficient just because the specification of Hyatt '022 was deemed to be deficient. The two disclosures are not the same and the state of the art had changed between the filing of the two disclosures. The adequacy of the disclosure of Hyatt '022 should only be relevant to the issue of whether appellant is entitled to the filing date of Hyatt '022 for purposes of eliminating certain prior art references. A rejection of the claims as lacking enablement must be based on the disclosure of this patent undergoing reexamination and not on some other patent's disclosure. The burden is also on the examiner to support the rejection, as it is with any rejection of the claims. In the examiner's rejection this burden has improperly been shifted to appellant.

We are also of the view that the original claims in the patent were clearly directed to television and moving picture systems. The adequacy of the disclosure to support these limitations, therefore, must have been considered during the original examination as part of the determination to issue a patent on those claims. Although this rejection was entered by the Board as a new ground of rejection, we agree with appellant that the assertion of this rejection now violates the spirit of the reexamination statute as discussed in Portola and Recreative Technologies. We also note that even though this rejection includes claims which were not present in the original patent, the added claims recite no limitations with respect to television and moving pictures which raise a new question regarding the sufficiency of the disclosure with respect to these features.

REJECTION 2

Rejection 2 also corresponds exactly to a new ground of rejection entered by the Board in the previous appeal involving this reexamination proceeding [Appeal 92-0829, decided August 26, 1993]. The new ground of rejection was made under the first paragraph of 35 U.S.C. § 112 based on the

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position that claims

1-4, 6-8, 15-31, 37-41, 50-55, 57, 58, 61-68, 73-75, 81-83, 85, 86, 89 and 90 were broader than the disclosure.

Specifically, the Board determined that these claims included television and moving picture embodiments within their scope which embodiments were not enabled by the disclosure [previous decision, pages 22-24]. The reasoning was analogous to a rejection on undue breadth usually found only in chemical cases.

Appellant makes several arguments related to the merits of this rejection. Appellant also argues that this issue has been improperly asserted as part of a reexamination proceeding [reply briefs].

We will not sustain this rejection. Once again, the original claims in the patent included television and moving picture systems within their scope. The adequacy of the disclosure to support the claims, therefore, must have been considered during the original examination as part of the determination to issue a patent on those claims. Although this rejection was entered by the Board as a new ground of

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rejection, we agree with appellant that the assertion of this rejection now violates the spirit of the reexamination statute as discussed in Portola and Recreative Technologies.

We also note that even though this rejection includes claims which were not present in the original patent, the issue of undue breadth with respect to the added claims raises no new question regarding the sufficiency of the disclosure with respect to these claims. We also consider the issue of undue breadth to be improperly raised in the previous Board decision. Appellant is not required to provide enabling disclosures for embodiments which are narrower than what is set forth in the claims.

REJECTION 3

Rejection 3 also corresponds exactly to a new ground of rejection entered by the Board in the previous appeal involving this reexamination proceeding [Appeal 92-0829, decided August 26, 1993]. The new ground of rejection was made under 35 U.S.C. § 305 based on the position that claims 2-90 were broader than original patent claims [previous decision, pages 25-27]. The Board objected to appellant's failure to properly show the difference between original

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claims and amended claims by underlining and bracketing as required by the rules of practice. It is noted that appellant compared amended claims to different claims of the original patent but not to the corresponding numbered claims of the patent.

Appellant argues that the prohibition against the broadening of claims in a reexamination proceeding refers only to claims which are broader than any claim of the patent and not to corresponding claims in the reexamination proceeding [brief, pages 59-61]. We note that appellant has now filed a set of claims [Appendix I attached to paper filed June 2, 1995] which compares each claim of the reexamination proceeding to its corresponding claim of the original patent. We will not sustain this rejection.

In the previous decision the Board determined that the requirements of 35 U.S.C. § 305 apply on a claim by claim basis [pages 36-37]. That is, amended claim "n" of the reexamination cannot be broader than claim "n" as originally patented. We do not agree with this previous determination by the Board. The claim by claim comparison of breadth asserted by the examiner and the Board in the previous decision has the

unintended effect of prohibiting the broadening of a dependent claim of the patent even though such an amended claim cannot be broader than the original claim from which it depended. We cannot accept that the reexamination statute was intended to prohibit such amendments of dependent claims.

As noted above, appellant has now filed a set of claims which properly compares the amended claims to the original claims. Some of these claims have not been amended at all [e.g., claims 9, 16 and 20] or have clearly only been narrowed [e.g., claims 5-8 and 38]. Thus, the blanket rejection of claims 2-90 under 35 U.S.C. § 305 has not been properly established by the examiner. It is the duty of the examiner to explain precisely how the claims of the reexamination are broader than the claims of the original patent. We have not been provided that

explanation so we do not sustain the rejection of claims 2-90 under 35 U.S.C. § 305.

REJECTION 4

Rejection 4 also corresponds exactly to a new ground of rejection entered by the Board in the previous appeal

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involving this reexamination proceeding [Appeal 92-0829, decided August 26, 1993]. The new ground of rejection was made under the first paragraph of 35 U.S.C. § 112 based on the position that there was an inadequate written description of claims 2-90. Specifically, the Board determined that the various items incorporated into the specification of the patent failed to establish that appellant was in possession of the invention as of the filing date of the application [previous decision, pages 27-34].

Appellant makes several arguments related to the merits of this rejection. Appellant also argues that this issue has been improperly asserted as part of a reexamination proceeding [reply briefs].

We will not sustain this rejection with respect to those claims in this reexamination proceeding which have not been amended or have been amended only slightly. Once again, these original claims in the patent included the same limitations which have been challenged here. The adequacy of the disclosure to support these claims, therefore, must have been considered during the original examination as part of the determination to issue a patent on those claims. Although

this rejection was entered by the Board as a new ground of rejection, we agree with appellant that the assertion of this rejection now violates the spirit of the reexamination statute as discussed in Portola and Recreative Technologies. For purposes of this rejection, the claims which have not been amended or have had only minor amendments are claims 1-4, 9-14, 16, 17, 20, 22-26, 29-31, 33-38, 42, 44-47, 50, 51, 53-56, 59, 60, 62, 63, 65, 66, 70-75, 77-79, 81-83 and 86-90.

We reach a different conclusion, however, with respect to those claims which have been significantly amended or added in this reexamination proceeding with limitations not previously claimed. This position primarily affects those claims which recite dynamic scattering and/or two-dimensional coincidental selection of display cells. The claims significantly amended or having these recitations include claims 5-8, 15, 18, 19, 21, 27, 28, 32, 39-41, 43, 48, 49, 52, 57, 58, 61, 64, 67-69, 76, 80, 84 and 85.

Appellant cannot seek the protection of Portola and Recreative Technologies when he has amended the claims to the point where the disclosure necessary to support such amended or new claims was not considered during the course of the

original prosecution of the patent. The basis for this rejection is that the original disclosure of this patent does not provide an adequate written description of the invention when one has to rely on all the materials incorporated by reference into the disclosure.

The patent upon which this request for reexamination was filed included a reference to several applications, patents and published books and articles. Columns 1-3 of the reexamined patent indicate 39 related applications and patents which are incorporated by reference in their entirety into the patent. The patent also refers to the prior art cited in several parent applications to the patent and also incorporates these prior art references in their entirety into the patent. Other prior art documents are referred to in the patent as background material which are not specifically incorporated by reference. Appellant argues that amendments made to the claims after the previous Board decision are supported by the Lechner article, which is one of the many documents incorporated by reference into the patent disclosure.

The incorporation by reference of the many

applications, patents and publications noted above impacts on the question of whether the specification satisfies the written description requirement of 35 U.S.C. § 112. It should always be kept in mind that the written description requirement is a separate and distinct requirement under 35 U.S.C. § 112, first paragraph. It is clearly separate from the enablement requirement. The purpose of the written description requirement is to ensure that the applicant conveys with reasonable clarity to those skilled in the art that he was in possession of the invention as of the effective filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Appellant is relying on information available in the incorporated materials as evidence that he was in possession of the invention now claimed as of the relied on filing date.

If all the material incorporated by reference in the reexamined patent were actually bodily written out in the patent, the patent would be thousands of columns long and filled with material which ranges from fairly irrelevant to

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the invention claimed here to closely related to the invention claimed here. The pervasive incorporation by reference used by appellant has the effect of attempting to place the entire body of prior art into the specification to support whatever claims appellant may choose to prosecute at any time. The fact that individual features of the claimed invention may be referenced in the prior art is not evidence that the combination of elements as now claimed was in appellant's possession as of the filing date of the application. To be effective in showing possession of the invention, an incorporation by reference must be specific as to what portion of an external text is being incorporated and for what purpose.

The issue as presented here is one of obligation on the part of an applicant to clearly demonstrate that he was in possession of the invention now claimed. For example, if an application was filed that incorporated by reference all patents that had issued in a given art area, such incorporation would not be evidence that every potential combination of these known teachings was already within the possession of the applicant. A standard of reasonableness

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must be applied that forces an applicant to make specific references to that material which he will later use as support for a later claimed invention.

It is our view that the scattering of teachings across multiple applications in a chain of continuing applications and across multiple references and references to references, under the facts of this case, constitutes a total failure to demonstrate that appellant was in possession, at the time of filing, of what is now claimed. The examiner had good reason to raise the question of whether the specification of the patent including all the incorporations by reference properly demonstrated possession by appellant of the invention as now claimed. The burden was properly shifted to appellant to demonstrate that the disclosure supported the position that he was in possession of the inventions currently being claimed. We find that appellant has not successfully met this burden. The reliance on Lechner and other incorporated materials, as noted above, is not sufficient to establish that appellant was in possession of the invention now being claimed.

REJECTION 5

This rejection was considered by the Board in its

previous decision [pages 36-37]. In that decision the Board sustained the rejection of claim 2 under 35 U.S.C. § 305. As noted above, we do not agree with the Board's previous interpretation of this section of the statute. Claim 2 is not broader than subject matter which was included within the scope of the original patent. Therefore, we do not sustain this rejection of claim 2 for reasons indicated above.

REJECTION 6

This rejection, unlike the other rejections discussed so far, has not been before the Board previously. This rejection is made under the first paragraph of 35 U.S.C. § 112 based on the examiner's position that the claimed limitation "having a plurality of multi-colored segments interspersed together, coupled to the illumination source and coupled to the electrical control circuit" as recited in claims 57 and 58 is new matter. Appellant points to two passages from an earlier Hyatt patent (3,986,022) which is designated as one of several parent applications to the patent being reexamined and which is incorporated by reference into the disclosure of the patent being reexamined [brief, page 64]. The examiner finds that

the passages referred to do not support the recitation of multi-colored segments interspersed together [answer, page 44].

Since claims 57 and 58 did not form part of the original patent, this particular issue was not before the examiner during the prosecution of the original patent, and the holdings of Portola and Recreative Technologies are not relevant to this issue. We agree with the examiner that the portions of Hyatt '022 referred to by appellant do not provide clear support for the terminology now being claimed in claims 57 and 58. Therefore, we sustain the examiner's rejection of claims 57 and 58 as containing new matter.

THE PRIOR ART REJECTIONS

We now direct our attention to the rejections based on the prior art. Before we consider the specific rejections, however, we consider general arguments made by appellant that the examiner has failed to establish a prima facie case of unpatentability. In support of these arguments appellant asserts that the examiner has not made the factual inquiries required by Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the examiner is attempting to combine incompatible

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references, the applied prior art lacks essential teachings, the examiner's rejections do not properly inform appellant as required by

35 U.S.C. § 132, and appellant was not properly furnished all of the applied prior art references [reply brief].

We have carefully considered the record in this proceeding, and we conclude that the examiner has properly made

a prima facie case of unpatentability for each of the prior art rejections before us. Appellant's arguments either relate to procedural considerations which have no bearing on the prima facie case or amount to nothing more than a disagreement with

the result reached by the examiner. For example, the failure to receive a reference or a belief that a rejection does not clearly state its basis are correctable by petition to the Commissioner. Appellant has not challenged during the course of prosecution that the rejections failed to properly convey the bases for the rejections.

An attack on the prima facie case is essentially a request for a directed verdict that as a matter of law, a

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rejection is legally insufficient and requires no response from the appellant. That is, appellant's request basically says that even if all the findings of the examiner are considered true and proven, such findings would be legally insufficient to support the conclusion of unpatentability. This is clearly not the situation before us. The prior art rejections before us have been carefully constructed by the Board in its previous decision and/or by the examiner, and all differences or alleged differences between the claimed invention and the teachings of the references have been addressed, and the obviousness of these differences have been explained or the lack of differences has been explained. Appellant and the examiner have extensively argued every little detail of the claimed invention and the teachings of the references. Even if the examiner had not originally made a prima facie case of unpatentability, the record now clearly includes a discussion of all differences presently asserted by appellant. Appellant's disagreement with the explanation of obviousness does not support the position that there is no prima facie case of unpatentability. At this point in the prosecution, patentability of the claimed invention is

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determined based on the relative persuasiveness of the arguments made by appellant and the examiner.

We next turn our attention to the question of whether appellant is entitled to the filing date of Hyatt '022 for purposes of eliminating any references published after the filing date of June 4, 1973. At the outset, we observe that an applicant is not necessarily entitled to the filing date of a previous application with respect to everything that is claimed. Each claim should be separately considered to determine if that particular claim is entitled to an earlier filing date.

The Board in its previous decision determined that appellant was not entitled to the filing date of Hyatt '022 for any of the claims on appeal at that time. This result was based upon the Board's findings that there were seven claimed elements not supported by Hyatt '022 and the fact that at least one of these seven elements was present in each of the claims. The examiner has simply followed this decision.

The record before us reflects that the examiner in the original prosecution of this patent undergoing reexamination was presented with the question of whether appellant was

entitled to the filing date of Hyatt '022. The examiner decided this question in appellant's favor and gave appellant the benefit of the filing date of Hyatt '022. Even though the claims now before us are not all identical to the claims considered during the course of the original examination, we think it was improper for the Board to raise the very same question which appellant had successfully prosecuted before the original examiner.

As we noted above, the decisions in Portola and Recreative Technologies would seem to prohibit the raising of issues which had been successfully prosecuted during the prosecution of the original patent. The reexamination statute was not intended to give the PTO an invitation to again raise issues which had been successfully prosecuted by the applicant in the grant of the original patent. The reexamination statute was designed primarily for a consideration of whether prior art not of record during the original prosecution could render the patented claims unpatentable. Even the proper grant of a request for reexamination, as is the case here, does not allow the PTO to again raise issues which had already been determined by the

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original examiner. A patentee should not have to keep winning the same issue over and over every time a reexamination of a patent is granted.

In view of the above comments, we have determined that appellant is entitled to the benefit of the filing date of Hyatt '022 because that is what the original examiner determined. Even though the Board in its original decision decided this question on the merits adversely to appellant, the subsequent decisions in Portola and Recreative Technologies lead us to conclude that this particular question was not properly raised here as part of a reexamination proceeding. This decision effectively eliminates any prior art rejections based on Ernstoff, Jacobson, Scheffer and Robertson.

We now turn our attention to the question of whether Taguchi is available as a prior art reference against the claims which recite a cooling means. Taguchi has a publication(Laid-open) date of June 30, 1977. Appellant has filed several declarations under 37 CFR § 1.131 to attempt to establish conception of the invention including cooling or heat transfer means prior to the Taguchi date along with

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diligence to a constructive reduction to practice with the filing of a patent application on December 13, 1977. The examiner has held the several declarations insufficient to warrant a date of invention before the Taguchi publication date. In the previous decision in this reexamination proceeding, the Board also considered appellant's evidence under 37 CFR § 1.131 to be insufficient to obtain a date before the Taguchi publication date. In a related reexamination proceeding, the Board found similar evidence insufficient to overcome the Taguchi filing date [appeal 96-1937, reexamination of Patent 4,471,385].

The evidence submitted by appellant can be grouped into the following categories: 1) evidence of conception; 2) evidence of discussions with Mattel; and 3) evidence of secretarial work related to this invention and other pending inventions. We consider each of these categories in order.

The evidence of conception is attempted to be demonstrated by Exhibits I-III of the initial Declaration filed under 37 CFR § 1.131. We find Exhibit I to be ineffective to demonstrate a conception of anything since it is completely unlabeled as to what the elements are supposed

to be. Appellant's recollection as to what the elements were intended to be, as remembered years later, cannot serve to explain a drawing which might be anything. Appellant argues that in the absence of contrary evidence, appellant's declaration must be accepted as true [brief, page 32]. We do not agree. Appellant's position would essentially eliminate the requirement that corroborative evidence be produced. Under appellant's position, a patentee could simply preempt the conception issue by stating that conception took place as of a certain date and filing evidence which is not supportive of such conception. Conception and diligence are factual issues which must be supported by appropriate evidence. Appellant cannot simply declare that conception took place as of a certain date or that appellant was diligent without providing acceptable supporting evidence. Thus, exhibit I does not support appellant's contention that conception of the invention involving the cooling means took place as of the date of that exhibit.

We find Exhibits II and III, however, sufficient to evidence a conception of the invention prior to the effective date of Taguchi. Although Exhibit II is undated, appellant's

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statement as to when this exhibit was drafted based on a specific telephone call as corroborated by appellant's phone records is sufficient to establish the date in an ex parte proceeding. Since Exhibit II appears to evidence the broad invention of the claims and the date is considered established, the conception of

the invention appears to be at a date earlier than the publication date of Taguchi.

The discussions with Mattel are ineffective to establish that diligence was occurring in reducing to practice the invention of the appealed claims. Appellant's declarations merely establish that between June 24, 1977 and August 25, 1977 several discussions and communications were had with Mattel which led to a decision to actually begin a reduction to practice on August 25, 1977. Before August 25, 1977, it appears that appellant's discussions with Mattel were for the sole purpose to see if it would be marketable or profitable to build such a device. Withholding work on actually reducing a conceived invention to practice while negotiating its commercial possibilities is not evidence of

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diligence in reducing the invention to practice. It is not clear from the evidence if appellant ever actually built a device incorporating the invention. There is no evidence of such, and if so, there is no evidence that it was ever tested for operability. If appellant did build something on November 1, 1977 for Mattel to consider, there is no evidence of its operability or of what transpired between November 1, 1977 and the constructive reduction to

practice that took place on December 13, 1977. These are unexplained gaps in the evidence of diligence in reducing the invention to practice.

The evidence of secretarial work is insufficient to establish the required diligence. The fact that the typist typed pages "related to" what is the invention on appeal before us is not specific as to what that means. What appellant considers to be related to this invention cannot be used to make a legal determination of whether such activity constitutes diligence as required by law. The secretary was working on several jobs for appellant at the same time, and only a couple of examples indicate specific work "related" to

what became the application upon which this patent issued.

Appellant notes that he was prosecuting several applications at the same time which related to the subject matter of this appeal. Again, the declarations do not make it clear that the prosecution of the other applications was an essential part of the work needed to reduce this invention to practice. Appellant simply concludes that since he worked on what he considered to be related applications, such work must inure to his benefit for purposes of establishing diligence in the reduction to practice of this invention. Appellant has not pointed out what prosecution of the related applications was essential in developing the invention of this application.

The evidence submitted by appellant still shows major gaps in which no evidence of diligence is presented. Appellant also must demonstrate that diligence began before the date of the Taguchi reference and continued non-stop up to the constructive reduction to practice. General statements that over periods of several months some work was done on the invention is too general to satisfy the requirement that evidence be specific. There is no specific evidence that anything was done toward reducing the invention to practice

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between conception and the critical date of June 30, 1977. Even a two day gap for an affidavit under 37 CFR § 1.131 cannot be overcome if there is simply no evidence. The critical time is from just prior to the reference date. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). To prove diligence, evidence must be specific as to dates as well as to facts and not be of a general nature. Nashef v. Pollack, 4 USPQ2d 1631, 1635 (Bd. Pat. App. & Int. 1987). A showing of diligence requires an accounting of the entire critical period. Griffith v. Kanamaru, 816 F.2d 624, 625-26, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987). Also, the fact that appellant had so many

irons in the fire cannot excuse the requirement for diligence in reducing an invention to practice

For all the reasons just discussed, we find the appellant's declarations under 37 CFR § 1.131 to be inadequate to predate the Taguchi reference with respect to claims reciting a cooling means or heat transfer means.

REJECTION 7

This rejection was considered by the Board in its previous decision [pages 37-41]. In that decision the Board sustained the rejection of claims 5-7, 18, 20, 39-41, 84 and 85 under 35 U.S.C. § 102 as being anticipated by Marie. Appellant has amended most of these claims to recite that the illumination control device is a flat panel display having a two-dimensional coincidentally selected array of pixel cells. Most of appellant's arguments in response to this rejection were considered by the Board in the previous decision. We see no reason to repeat the Board's response to these arguments or to reassert the specific findings and conclusions of the Board in the previous decision. The only argument not addressed previously is appellant's argument that the illumination amplifiers of the claims are completely different in construction and operating principle from that taught by Marie [brief, page 70]. As pointed out by the examiner, the Board in the previous decision determined that Marie disclosed a television receiver and that such a receiver is essentially flat as required by the claim language [answer, page 53]. We adopt this reasoning of the Board in its previous decision. Therefore, we again sustain this rejection of claims 5-7, 18,

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20, 39-41, 84 and 85 for reasons indicated in the previous decision as further discussed above.

REJECTION 8

Rejection 8 has not been previously considered by the Board. In this rejection claims 5-7, 18, 20, 39-41, 84 and 85 have been rejected under 35 U.S.C. § 103 as unpatentable over Marie taken with Lechner or Heilmeyer '112 in view of Zworykin. These same claims were rejected as anticipated by Marie, and that rejection was sustained [Rejection 7]. Since anticipation is the epitome of obviousness, we also sustain these rejections of the claims under 35 U.S.C. § 103. We also note for the record that this rejection would be considered proper regardless of the propriety of the rejection on Marie alone. Appellant's arguments that the prior art references have differences and are, therefore, incompatible and cannot be combined are not convincing. Appellant assumes that the prior art teachings would have to be bodily incorporated into each other which is not the appropriate standard for obviousness. The artisan would have recognized that obvious modifications would have to be made in combining the teachings of the references. We agree with the comments of the examiner

as set forth in the answer as to the insufficiency of appellant's arguments to overcome this rejection [pages 55-57].

We also note that these rejections were made by the examiner in case it was determined that the flat panel language of the claims was not met by Marie's television receiver. We agree with the examiner's position on this rejection and with the examiner's response to appellant's arguments with respect to this rejection [id.].

REJECTION 9

This rejection was considered by the Board in its previous decision [pages 41-43]. In that decision the Board sustained the rejection of claims 5, 7, 8, 19, 32, 39-41, 43, 48, 49 and 52 under 35 U.S.C. § 102 as being anticipated by Jacobson. Appellant has amended these claims to recite that the electro-optical device has a two-dimensional coincidentally selected array of pixel cells. Appellant argues that Jacobson is not available as prior art (except for claim 19) because appellant is entitled to the 1973 effective filing date of Hyatt '022. Most of appellant's other arguments in response to this rejection were considered by the

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Board in the previous decision. Appellant makes no arguments with respect to the specific added limitations to these claims noted above.

Even though we agree with appellant that he is entitled to the filing date of Hyatt '022 for claim limitations considered by the original examiner, we note that each of these claims recites new limitations never considered by the original examiner. For reasons noted above in our consideration of rejection 4, appellant is not entitled to the filing date of Hyatt '022 for these particular claim limitations. As pointed out by the examiner, the Board in the previous decision determined that Jacobson, like Marie, disclosed a television receiver that is a two-dimensional coincidentally selected array as required by the claim language [answer, pages 57-59]. We adopt the reasoning of the Board in its previous decision. The examiner has also properly responded to every point raised by appellant in the brief. Therefore, we again sustain this rejection of claims 5,7, 8, 19, 32, 39-41, 43, 48, 49 and 52 for reasons indicated in the previous decision and in the examiner's answer as further discussed above.

REJECTION 10

Rejection 10 has not been previously considered by the Board. In this rejection claims 5, 7, 8, 10, 19, 32, 39-41, 43, 48, 49 and 52 have been rejected under 35 U.S.C. § 103 as unpatentable over Jacobson taken with Lechner or Heilmeier '112. These same claims, except for claim 10, were rejected as anticipated by Jacobson, and that rejection was sustained [Rejection 9]. Since anticipation is the epitome of obviousness, we also sustain these rejections of the claims under 35 U.S.C. § 103.

We also note that these rejections were made by the examiner in case it was determined that the two-dimensional language of the claims was not met by Jacobson's electro-optical system. We agree with the examiner's position on this rejection and with the examiner's response to appellant's arguments with respect to this rejection [answer, pages 60-62].

With respect to claim 10, we find that this claim has had only minor amendments from the claim considered by the original examiner. Therefore, we believe that this claim is entitled to the benefit of the filing date of Hyatt '022 as

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determined by the original examiner. Accordingly, Jacobson is not a valid

reference against claim 10. The rejection, therefore, is sustained for all the claims except for claim 10.

REJECTION 11

This rejection was considered by the Board in its previous decision [pages 43-44]. In that decision the Board sustained the rejection of claims 5, 7, 39, 40, 42 and 52 under 35 U.S.C. § 102 as being anticipated by the Angus Robertson article. Appellant has amended these claims, except for claim 42, to recite that the electro-optical device has a two-dimensional coincidentally selected array of pixel cells. Appellant argues that Robertson is not available as prior art because appellant is entitled to the 1973 effective filing date of Hyatt '022. Appellant argues that the Robertson display provides only one-dimensional selection, not two-dimensional selection as claimed. Most of appellant's other arguments in response to this rejection were considered by the Board in the previous decision. As discussed above in our consideration of rejections 4 and 10, appellant is not

entitled to the filing date of Hyatt '022 for claims reciting the two-dimensional selection limitations. The examiner has correctly addressed each of the arguments made by appellant in response to this rejection [answer, pages 62-64]. We adopt the reasoning of the Board in its previous decision and the examiner in the answer. Therefore, we again sustain this rejection of claims 5, 7, 39, 40 and 52 for reasons indicated in the previous decision and the answer as discussed above. Since claim 42 has not been significantly amended, we do not sustain the rejection of claim 42 because claim 42 is entitled to the filing date of Hyatt '022 which eliminates Robertson as a valid reference.

REJECTION 12

This rejection was considered by the Board in its previous decision [pages 44-45]. In that decision the Board sustained the rejection of claims 10, 32, 43, 48 and 49 under 35 U.S.C. § 102 as being anticipated by Jacobson. With the exception of the inclusion of claim 10, this rejection duplicates rejection 9. Therefore, we again sustain the rejection of claims 32, 43, 48 and 49 for the reasons given previously. Since claim 10 has had only minor amendments,

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however, we do not sustain the rejection of claim 10 because Jacobson is not a valid reference against claim 10 for reasons discussed above.

REJECTION 13

This rejection was considered by the Board in its previous decision [pages 45-47]. In that decision the Board sustained the rejection of claims 56, 57, 74 and 75 under 35 U.S.C. § 103 as being unpatentable over Robertson in view of Marie, Scheffer, Jacobson and Ernstoff '968. Appellant argues that none of Jacobson, Scheffer, Robertson or Ernstoff is available as prior art because appellant is entitled to the 1973 effective filing date of Hyatt '022. All of appellant's other arguments in response to this rejection were considered by the Board in the previous decision. We are of the view that claims 56, 74 and 75 are not significantly different from claims considered by the original examiner. Therefore, we agree with appellant that Jacobson, Scheffer, Robertson and Ernstoff are not valid prior art references with respect to these claims. Accordingly, we do not sustain this rejection of claims 56, 74 and 75 for reasons as discussed above. Claim 57 has been amended, however, to recite a dynamic scattering

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of source illumination. There is no support in Hyatt '022 for this limitation. Therefore, appellant is not entitled to the filing date of Hyatt '022 with respect to claim 57. Accordingly, this rejection of claim 57 is sustained.

REJECTION 14

This rejection has not been previously considered by the Board. In this rejection claims 56, 57, 74 and 75 have been rejected under 35 U.S.C. § 103 as unpatentable over any of Robertson, Marie, Scheffer and/or Jacobson in view of Ernstoff '968. These are the same claims and references we considered in rejection 13. Appellant argues that the manner in which the references are combined would not have been obvious to one having ordinary skill in the art [brief, page 84]. Other than this broad assertion, appellant has not specifically identified the error in combining these references as used by the Board in rejection 13 or as explained by the examiner in the rejection. Nevertheless, appellant is entitled to the filing date of Hyatt '022 for claims 56, 74 and 75 which eliminates four of these references as discussed above. Therefore, we do not sustain this rejection of claims 56, 74 and 75. We do sustain this

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rejection of claim 57 for reasons discussed by the examiner in the answer.

REJECTION 15

This rejection was considered by the Board in its previous decision [page 47]. In that decision the Board sustained the rejection of claim 58 under 35 U.S.C. § 103 as being unpatentable over Jacobson in view of Marie, Scheffer and Ernstoff '968. Appellant argues that none of Jacobson, Scheffer, or Ernstoff is available as prior art because appellant is entitled to the 1973 effective filing date of Hyatt '022. This claim recites dynamic scattering and is not entitled to the Hyatt '022 filing date as just discussed with respect to claim 57. Appellant also argues the propriety of combining the teachings of Jacobson with the secondary references. The examiner has properly addressed this argument made by appellant in response to this rejection [answer, pages 70-71]. We adopt the reasoning of the examiner in the answer. Therefore, we sustain this rejection of claim 58.

REJECTION 16

This rejection was considered by the Board in its previous decision [pages 47-50]. In that decision the Board

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sustained the rejection of claim 86 under 35 U.S.C. § 103 as being unpatentable over Roth in view of Heilmeier '112. Claim 86 has only minor amendments from the claim previously considered by the Board. Appellant argues that Roth is unavailable as prior art because appellant is entitled to the 1973 effective filing date of Hyatt '022. Appellant also argues the propriety of combining the teachings of Roth and Heilmeier '112 as proposed by the Board in the previous decision.

With respect to the first point argued by appellant, Hyatt '022 has a filing date of June 4, 1973. Roth has a filing date of June 26, 1972 for purposes of qualifying as prior art under 35 U.S.C. § 102(e). Therefore, Roth is available as prior art against the claims on appeal. With respect to the second point argued by appellant, the examiner has properly addressed this argument in the response to this rejection [answer, pages 72-74]. We adopt the reasoning of the examiner in the answer. Therefore, we sustain this rejection of claim 86.

REJECTION 17

This rejection was considered by the Board in its

previous decision [pages 50-51]. In that decision the Board sustained the rejection of claim 38 under 35 U.S.C. § 112, first paragraph, as lacking enablement. Claim 38 has been amended from the original patent. The rejection is based on lack of support for this amended material. Appellant argues that the incorporation by reference of Warner and Lechner satisfies the disclosure requirements of 35 U.S.C. § 112. We have considered the reliance on Lechner and other material proposed to be incorporated by reference above for purposes of satisfying the requirements of 35 U.S.C. § 112. Therefore, for reasons discussed above, we sustain the rejection of claim 38 as not being supported by the disclosure of the patent as filed.

REJECTION 18

This rejection was considered by the Board in its previous decision [pages 52-54]. In that decision the Board sustained the rejection of claims 9, 11-15, 17, 22, 24, 28, 33, 44, 59 and 87 under 35 U.S.C. § 103 as being unpatentable over Roth in view of Heilmeier '112 and Lechner. Appellant argues that there is no basis to substitute the Heilmeier '112 reflective modulator for the Roth transmissive modulator as

proposed by the Board in the previous decision. Appellant also points to the multiple light sources of some of these claims [brief, pages 89-91]. Appellant has presented no additional evidence or arguments to compel us to reverse the factual findings made by the Board in the previous decision. The examiner has also properly addressed these and other arguments made by appellant in response to this rejection [answer, pages 75-78]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 9, 11-15, 17, 22, 24, 28, 33, 44, 59 and 87.

REJECTION 19

This rejection was considered by the Board in its previous decision [pages 54-56]. In that decision the Board sustained the rejection of claims 1, 3, 16, 19, 23, 25, 26, 29-31, 34-37, 45-47, 50, 51, 54, 67, 72, 77, 79 and 82 under 35 U.S.C. § 103 as being unpatentable over Roth in view of Heilmeier '112, Lechner, Taguchi and Fergason. Appellant argues that the rejection improperly combines disparate teachings from the prior art. Appellant also repeats several arguments which have been discussed above [brief, pages 91-

94]. Appellant has presented no additional evidence or arguments to compel us to reverse the factual findings made by the Board in the previous decision. The examiner has properly addressed these arguments made by appellant in response to this rejection [answer, pages 78-82]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 1, 3, 16, 19, 23, 25, 26, 29-31, 34-37, 45-47, 50, 51, 54, 67, 72, 77, 79 and 82.

REJECTION 20

This rejection was considered by the Board in its previous decision [pages 56-58]. In that decision the Board sustained the rejection of claims 4, 55 and 83 under 35 U.S.C. § 103 as being unpatentable over Hanlon in view of Heilmeier '112, Taguchi, Ferguson and Lechner. These claims have had only minor amendments from the claims previously considered by the Board. Appellant argues that these claims recite a limitation which was considered patentable by the Board of Patent Appeals and Interferences in a related application. We agree with the examiner's response that the claims of each application must be considered on their own merits. The

findings of one panel of the Board in one application are not necessarily binding on the findings of a different panel of the Board in a different application. Appellant has basically presented no arguments in response to this rejection made by the Board in its previous decision other than to simply assert that the Board's rejection is incorrect or to restate arguments which have been previously considered by the Board and the examiner. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 82-86]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 4, 55 and 83.

REJECTION 21

This rejection was considered by the Board in its previous decision [pages 58-59]. In that decision the Board sustained the rejection of claims 21, 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Roth. Appellant has amended these claims to recite that the electro-optical device has a flat panel two-dimensional coincidentally selected array of pixel cells. This feature is considered obvious over Roth

for the same reasons discussed above with respect to other references teaching a television receiver as the electro-optical device. All of the remaining arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 87-88]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 21, 27 and 28.

REJECTION 22

This rejection was considered by the Board in its previous decision [pages 59-60]. In that decision the Board sustained the rejection of claims 52, 61, 68, 76 and 80 under 35 U.S.C. § 103 as being unpatentable over Hanlon in view of Fischer and Lechner. Appellant has amended these claims to recite that the illumination amplifier generates dynamically scattered light. We agree with the examiner that Fischer teaches the broad recitation of dynamically scattering light in response to source illumination. All of the remaining

arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 88-90]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 52, 61, 68, 76 and 80.

REJECTION 23

This rejection was considered by the Board in its previous decision [pages 60-61]. In that decision the Board sustained the rejection of claims 60, 65 and 69 under 35 U.S.C. § 103 as being unpatentable over Hanlon in view of Fischer and Lechner. All of appellant's arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 90-92]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer.

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Therefore, we sustain this rejection of claims 60, 65 and 69.

REJECTION 24

Rejection 24 also corresponds exactly to a new ground of rejection entered by the Board in the previous appeal involving this reexamination proceeding [Appeal 92-0829, decided August 26, 1993]. The new ground of rejection was made under 35 U.S.C. § 103 based on the position that claim 53 was unpatentable over the teachings of Hanlon and Fischer in view of Lechner, Taguchi and Ferguson [previous decision, page 61]. Only minor amendments have been made to claim 53 since the previous Board decision. All of appellant's arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 93-95]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claim 53.

REJECTION 25

This rejection was considered by the Board in its previous decision [pages 61-62]. In that decision the Board sustained the rejection of claims 64 and 67 under 35 U.S.C.

§ 103 as being unpatentable over Hanlon in view of Fischer and Fergason. Appellant has amended these claims to recite that the illumination amplifier generates dynamically scattered light. We agree with the examiner as noted earlier that Fischer teaches the broad recitation of dynamically scattering light in response to source illumination. All of the remaining arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 95-98]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claims 64 and 67.

REJECTION 26

This rejection was considered by the Board in its previous decision [page 62]. In that decision the Board sustained the rejection of claims 62, 66, 71-73 and 77-79

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under 35 U.S.C. § 103 as being unpatentable over Hanlon, Fischer, Lechner and Ferguson. Only minor amendments have been made to these claims since the previous Board decision. All of appellant's arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. Therefore, we sustain this rejection of claims 62, 66, 71-73 and 77-79 for the same reasons that we have discussed above.

REJECTION 27

This rejection was considered by the Board in its previous decision [pages 63-64]. In that decision the Board sustained the rejection of claims 74, 75, 81, 84, 85 and 88-90 under 35 U.S.C. § 103 as being unpatentable over Marie in view of Lechner and Ferguson. All of appellant's arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 99-102]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the

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answer. Therefore, we sustain this rejection of claims 74, 75, 81, 84, 85 and 88-90.

REJECTION 28

This rejection was considered by the Board in its previous decision [pages 65-66]. In that decision the Board sustained the rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over Lechner in view of de Quervain and Ferguson. All of appellant's arguments with respect to this rejection simply repeat arguments previously considered or simply assert that the Board's rejection is incorrect. The examiner again has properly addressed each of the arguments made by appellant in response to this rejection [answer, pages 102-104]. We adopt the reasoning of the Board in the previous decision as well as the examiner in the answer. Therefore, we sustain this rejection of claim 2.

THE DOUBLE PATENTING REJECTIONS

Before we consider any of the double patenting rejections on the merits, we must address appellant's argument that the decisions in Portola and Recreative Technologies prohibit these double patenting rejections. Appellant asserts that since the two Hyatt patents forming the basis for all

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double patenting rejections here were part of the record during prosecution of the original patent, the examiner must be presumed to have made a specific decision that these double patenting rejections do not apply. Therefore, according to appellant, these rejections cannot be asserted here for the first time.

The Portola and Recreative Technologies decisions would be more relevant here if a double patenting rejection had been made and overcome during prosecution of the Hyatt '396 patent. There is no evidence, however, in the file of Hyatt '396 that the examiner ever considered the propriety of a double patenting rejection. It is clear in our view, however, that a double patenting rejection of the claims of Hyatt '396 could have been made on the claims of the Hyatt '385 or Hyatt '732 patents during the original prosecution of the application leading to Hyatt '396. Thus, the question on this record is whether a double patenting rejection can be maintained here when it was not made during the original prosecution but could have been.

The issue of double patenting in this case differs in a very material respect from the facts in Portola and

Recreative Technologies. In this case, the reexamination request was granted in order to consider additional prior art cited by a third party requester, and this prior art was applied in the rejections previously discussed under 35 U.S.C. § 103. Therefore, the reexamination proceeding here was properly undertaken whether or not the double patenting rejection had been made. The question is whether an issue which could have been raised in the original patent but was not raised can be raised during a reexamination proceeding which has been granted on other appropriate grounds.

As we noted above, this issue is affected by the course of prosecution of the original patent. Our review of the record available to us leads us to infer that it is quite likely that the examiner never considered a double patenting rejection. We also find it to be relevant that appellant incorporates so many copending applications into the disclosure as noted above. When an application notes that it is related to almost forty other applications as is the case here, it is easy to accept the fact that an examiner is simply overwhelmed and does not review each of these related applications to ascertain questions of double patenting. We

think that it is unrealistic to expect that the examiner during the original prosecution considered each of the related cases for double patenting considerations.

Under these facts, we think it was appropriate for the examiner to raise the double patenting issue for the first time during this reexamination proceeding since the proceeding was properly granted based on new prior art which was applied in a separate rejection. If the examiner clearly overlooked an appropriate rejection in the parent prosecution, it would make no sense to us to preclude the examiner from this rejection raising in a reexamination proceeding which has otherwise been properly initiated. Thus, on the particular facts of this case, we hold that the examiner is not precluded by Portola and Recreative Technologies from making a double patenting rejection for the first time in addition to a new rejection on prior art. Also, note In re Lonardo, 119 F.3d 960, 43 USPQ2d 1262 (Fed. Cir. 1997) wherein the court approved, after Portola and Recreative Technologies, the propriety of applying obviousness-type double patenting rejections in a reexamination proceeding.

Since we have decided that the double patenting

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rejection may be considered as part of this reexamination proceeding, we must now consider whether the test for two-way obviousness must be met or whether one-way obviousness is sufficient. Appellant argues that the examiner is required to show two-way obviousness whereas the examiner asserts that only one-way obviousness is necessary. We note that the claims in this reexamination proceeding appear to be narrower than claims 10 and 12-16 of Hyatt '385 or claims 18, 25, 28-30 and 32 of Hyatt '732.

The differences between the application of one-way obviousness determinations and two-way obviousness determinations have been clarified by the courts as recognized by the examiner and appellant. In In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991), the court held that a two-way obviousness determination must be satisfied in the situation where an applicant is not at fault that narrower claims may have issued before broader ones. On the record now before us, however, the narrower claims were not the first to issue. The broader claims issued first. Thus, the two-way obviousness determination is not

technically relevant here because the narrower claims were not the first to issue. Even if two-way obviousness were considered necessary, the broader claims of Hyatt '385 and Hyatt '732 would be considered obvious over the narrower claims presently on appeal. It has been noted that "[a] second application -- 'containing a broader claim, more generical in its character than the specific claim in the prior patent' -- typically cannot support an independent valid patent," In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993), citing Miller v. Eagle Mfg. Co., 151 U.S. 186, 198 (1894). Thus, the court in Goodman decided that generically broader claims are generally obvious over their more narrow counterparts. See also In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998) on two-way versus one-way obviousness. Since the broader claims of Hyatt '385 and Hyatt '732 are presumed to be obvious over the narrower claims on appeal in this reexamination, a determination of the obviousness of these appealed claims over the claims of Hyatt '385 and Hyatt '732 is sufficient.

Appellant argues that the double patenting rejections here improperly apply the rule of In re Schneller, 397 F.2d

350, 158 USPQ 210 (CCPA 1968). We do not agree. All of the double patenting rejections before us on appeal, except for the last one, are clearly designated as being based on the judicially created doctrine of obviousness-type double patenting. To further clarify this issue, we state for the record that we consider each of the double patenting rejections before us with respect to the laws governing obviousness-type double patenting rejections only.

Appellant also argues that the double patenting rejections are precluded by previously made restriction requirements. Because appellant has identified so many related applications and prosecuted similar claims in these applications, it is impossible for us to determine if the requirements of any previous restriction requirements have been maintained. It appears that distinctions between restricted inventions disappeared from the various applications shortly after they were required. At any rate, we have no evidence before us that the claims of this reexamination proceeding are in conformance with a restriction requirement made in either Hyatt '385 or Hyatt '732.

Appellant also argues that double patenting is

prohibited because these claims are independent and distinct from the claims of Hyatt '385 and Hyatt '732. Since all the double patenting rejections before us are of the obviousness-type, the questions of independence and distinctness are irrelevant. The only relevant question is whether the claims now rejected would have been obvious to the artisan over a claim of Hyatt '385 or Hyatt '732 in view of additional prior art.

DOUBLE PATENTING REJECTIONS BASED ON HYATT '385

REJECTION 29

This double patenting rejection applies to appealed claims 1 and 2 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner, de Quervain and Ferguson. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 26-31]. For purposes of this analysis, we consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Appellant argues that the examiner has improperly relied on the disclosure of Hyatt '385 to demonstrate obviousness. For example, appellant argues that only the disclosure of Hyatt '385 provides the electrical control

circuit. We disagree with appellant for at least two reasons. First, claim 14 of Hyatt '385 recites a "control means for generating an electrical control signal." This suggests an electrical control circuit by the very language of the claim. Second, the elements of the claims in Hyatt '385 are recited in means plus function form. The only way to ascertain the scope of these claims is to consider the disclosure as required by the sixth paragraph of 35 U.S.C. § 112. Thus, appellant cannot seek the advantages of claiming in means plus function form and then complain that the disclosure has been used to measure the scope of the claim.

Appellant's other arguments relate to alleged improprieties in combining claim 16 of Hyatt '385 with the "different" systems of Lechner, de Quervain and Ferguson. Since the question of the combinability of these references was considered above and decided adversely to appellant [see rejection 28, for example], we incorporate the relevant discussion above regarding the obviousness of combining these teachings. Therefore, we sustain this double patenting rejection of claims 1 and 2.

REJECTION 30

This double patenting rejection applies to appealed claims 3, 9, 11-17, 19, 22-26, 28-40, 42, 44-52, 54, 56, 59, 84, 85 and 87-90 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner, Roth and Heilmeier. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 31-70]. For purposes of this analysis, we again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Appellant and the examiner have extensively argued the issues with respect to this rejection [brief, pages 116-136; answer, pages 109-130]. Since all of appellant's arguments have either been considered above in our discussion of the double patenting rejection or in our discussion of the references as applied in the previous prior art rejections, or have been appropriately responded to by the examiner in the answer, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 31

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This double patenting rejection applies to appealed claims 4, 55 and 83 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner and Hanlon. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 70-74]. For purposes of this analysis, we again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Once again, appellant and the examiner have extensively argued their differences with respect to the rejection of these claims. Although appellant basically disagrees with all the

factual findings of the examiner, we find the examiner's position to be consistent with the findings within the previous Board decision, with the findings this panel has made in our previous discussions above, and with findings of the examiner which this panel has already found to be persuasive above. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 32

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This double patenting rejection applies to appealed claims 5-8, 18, 20, 41, 42, 74, 75, 84 and 85 as compared to claims 10 and 12-16 of Hyatt '385 in view of Marie. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 75-87]. For purposes of this analysis, we consider either claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Appellant and the examiner have extensively argued the issues with respect to this rejection [brief, pages 139-147; answer, pages 133-138]. Since all of appellant's arguments have either been considered above in our discussion of the double patenting rejection or in our discussion of the references as applied in the previous prior art rejections, or have been appropriately responded to by the examiner in the answer, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 33

This double patenting rejection applies to appealed

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claims 8 and 43 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner and Jacobson or Marie. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 88-92]. For purposes of this analysis, we again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Once again, appellant and the examiner have extensively argued their differences with respect to the rejection of these claims. Each of appellant's arguments has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 34

This double patenting rejection applies to appealed claim 10 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix

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A, pages 92-95]. For purposes of this analysis, we consider either claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of claim 10 based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 35

This double patenting rejection applies to appealed claims 21, 27 and 28 as compared to claims 10 and 12-16 of Hyatt '385 in view of Roth. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 95-98]. For purposes of this analysis, we again consider

claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

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Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of claims 21, 27 and 28 based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 36

This double patenting rejection applies to appealed claims 9, 74, 75, 81, 82 and 88-90 as compared to claims 10 and 12-16 of Hyatt '385 in view of Lechner and Marie. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 99-102]. For purposes of this analysis, we consider claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting

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rejection

of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 37

This double patenting rejection applies to appealed claims 52, 57, 58, 64, 67, 68 and 76 as compared to claims 10 and 12-16 of Hyatt '385 in view of Fischer. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 102-108]. For purposes of this analysis, we consider claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 38

This double patenting rejection applies to appealed claims 53, 60-63, 65, 66, 69-73 and 77-80 as compared to claims 10 and 12-16 of Hyatt '385 in view of Fischer and Lechner. The examiner has fully explained this rejection, and it will not be repeated here [answer, Appendix A, pages 108-113]. For purposes of this analysis, we consider claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 39

This double patenting rejection applies to appealed claim 86 as compared to claims 10 and 12-16 of Hyatt '385 in view of Roth and Heilmeier. The examiner has fully explained

this rejection, and it will not be repeated here [answer, Appendix A, pages 114-118]. For purposes of this analysis, we consider claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or again consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

DOUBLE PATENTING REJECTIONS BASED ON HYATT '732

Before considering each of these rejections on the merits, we note that the examiner and appellant have recognized that most of the substantive issues have been previously considered in the rejections discussed previously. Because of this fact, the examiner and appellant have incorporated many arguments previously made and considered with respect to the previous discussion. We also desire to simplify this record where possible, and therefore, we also incorporate any and all of our discussion above as it relates

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to each of these specific double patenting rejections before us on appeal.

REJECTION 40

This double patenting rejection applies to appealed claims 1, 3, 5-11, 15, 18, 20, 41-43, 74, 75, 81, 82, 84, 85 and 88 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie. Although several claims from Hyatt '732 are listed by the examiner and appellant argues that the examiner has improperly combined claims in supporting the double patenting rejections, we recognize that only a single one of the listed claims can form the basis for any one of these rejections. Some of these claims are dependent claims which incorporate the limitations of the claims from which they depend. It is sufficient to note that we consider the examiner's position and appellant's arguments with respect to a single selected claim from Hyatt '732 for each rejected claim on appeal before us. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject

matter of claims 18, 28 and 29.

Most of appellant's substantive arguments with respect to this rejection have been considered at some point in this decision above, and we incorporate any relevant discussion from above. Appellant also argues that the coherent illumination source of claim 3 requires claim 32 of Hyatt '732 which is not one of the claims upon which the rejection is properly based. Claim 32 of Hyatt '732, however, is not needed to support this rejection. Marie teaches that light source 1 could respectively be three different light sources of red, green and blue. Such a teaching suggests the obviousness of a coherent light source as claimed. Appellant argues that the plurality of liquid crystal devices of claim 8 requires claim 2 of Hyatt '732 which is not one of the claims upon which the rejection is properly based. Claim 2 of Hyatt '732, however, is not needed to support this rejection. Marie teaches that a plurality of illumination control devices can be used to generate color signals, and Marie suggests that crystalline devices (LCDs) can act as illumination control devices. Therefore, we sustain this double patenting rejection of the claims based on our discussion herein, the

reasoning of the examiner and our previous relevant discussion.

REJECTION 41

This double patenting rejection applies to appealed claims 1, 3, 5, 7-11, 15, 18, 52, 53, 57, 58, 60-73 and 76-80 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer and Lechner. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject matter of claims 18, 28 and 29.

Once again, most of appellant's substantive arguments with respect to this rejection have been considered at some point in this decision above, and we incorporate any relevant discussion from above. Appellant again argues that the coherent illumination source of claim 3 requires claim 32 of Hyatt '732 which is not one of the claims upon which the rejection is properly based. Claim 32 of Hyatt '732, however, is not needed to support this rejection. Fischer teaches that a light source is filtered to provide red, green and blue inputs. Such a teaching suggests the obviousness of a coherent light source as claimed. Therefore, we sustain this

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double patenting rejection of the claims based on our discussion herein, the reasoning of the examiner and our previous relevant discussion.

REJECTION 42

This double patenting rejection applies to appealed claim 2 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer, Lechner and de Quervain. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject matter of claims 18, 28 and 29.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection

of claim 2 based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 43

This double patenting rejection applies to appealed claim 2 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie and de Quervain. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject matter of claims 18, 28 and 29.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of claim 2 based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 44

This double patenting rejection applies to appealed claims 4, 55 and 83 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Hanlon. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which

incorporates the subject matter of claims 18, 28 and 29.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 45

This double patenting rejection applies to appealed claims 12-40, 42, 44-52, 54, 56, 59 and 84-90 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Roth, Lechner and Heilmeier. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject matter of claims 18, 28 and 29.

Each of appellant's arguments with respect to this rejection has been considered at some point in this decision above, and each of these arguments has been decided adversely to appellant. Therefore, we sustain this double patenting rejection

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of the claims based on the reasoning of the examiner and our previous relevant discussion.

REJECTION 46

This double patenting rejection applies to appealed claims 1-90 as compared to claims 10 and 12-16 of Hyatt '385 taken alone. For purposes of this analysis, we consider claim 12 of Hyatt '385 which incorporates the subject matter of claim 10 or consider claim 16 of Hyatt '385 which incorporates the subject matter of claims 13-15.

Although the inventions of claims 1-90 are different, the examiner has determined that each of these claims is obvious over the claims of Hyatt '385 when the claims of Hyatt '385 are interpreted in light of the disclosure. Even though we agreed with the examiner earlier that claims drafted in means plus function form must be construed in light of the disclosure, that does not mean that the entire disclosure should be read into the claim for each and every claim. The theory of claim differentiation suggests that differences between claims must be presumed to cover different inventions. The examiner has basically determined that the entire disclosure of Hyatt '385 is included within claim 12 or 16 so

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that each of these claims include everything which is recited in appealed claims 1-90.

We agree with appellant that the examiner has failed to establish a prima facie case of unpatentability with his blanket rejection of claims 1-90 based on Hyatt '385 taken alone. However, the exact structure which should be read into the claims of Hyatt '385 and appealed claims 1-90 requires factual findings by the examiner and responsive positions of appellant to properly ascertain the scope of each of the claims of Hyatt '385 and the appealed claims so as to measure the true differences therebetween. Since these factual findings are not of record in this case, we do not sustain this rejection of claims 1-90.

REJECTION 47

This double patenting rejection applies to appealed claims 1-90 as compared to claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 taken alone. For purposes of this analysis, we primarily consider claim 16 of Hyatt '732 which incorporates the subject matter of claim 1 or consider claim 30 of Hyatt '732 which incorporates the subject matter of claims 18, 28 and 29.

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Everything we said with respect to the rejection just discussed previously applies equally to this rejection. Therefore, we also do not sustain this rejection of claims 1-90.

REJECTION 48

This double patenting rejection applies to appealed claims 1-90 as being unpatentable over Hyatt '385 or Hyatt '732. For purposes of this analysis, the examiner has not considered any specific claim of Hyatt '385 or Hyatt '732, but rather, the examiner simply views a patent granted on appealed claims 1-90 as constituting an unwarranted extension of the grant appellant received in Hyatt '385 and Hyatt '732.

We agree with appellant that the basis for this rejection is not entirely clear and that the examiner has failed to establish a prima facie case of unpatentability. Factual findings are also necessary here before it can be determined whether a patent granted on appealed claims 1-90 would improperly extend the patent grant appellant received in Hyatt '385 or Hyatt '732. Therefore, we do not sustain this rejection of claims

1-90.

SUMMARY

1. The rejection of claims 5, 9-14, 32-36, 42-49, 56, 59, 60, 69-72, 76-80, 84, 87 and 88 under 35 U.S.C. § 112, first paragraph, as lacking enablement is reversed.

2. The rejection of claims 1-4, 6-8, 15-31, 37-41, 50-55, 57, 58, 61-68, 73-75, 81-83, 85, 86, 89 and 90 under 35 U.S.C. § 112, first paragraph, as broader than the disclosure is reversed.

3. The rejection of claims 2-90 under 35 U.S.C. § 305 as broader than the original patent claims is reversed.

4. The rejection of claims 2-90 under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description is affirmed with respect to claims 5-8, 15, 18, 19, 21, 27, 28, 32, 39-41, 43, 48, 49, 52, 57, 58, 61, 64, 67-69, 76, 80, 84 and 85, but is reversed with respect to claims 1-4, 9-14, 16, 17, 20, 22-26, 29-31, 33-38, 42, 44-47, 50, 51, 53-56, 59, 60, 62, 63, 65, 66, 70-75, 77-79, 81-83 and 86-90.

5. The rejection of claim 2 under 35 U.S.C. § 305 as

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broader than the original patent claim is reversed.

6. The rejection of claims 57 and 58 under 35 U.S.C. § 112, first paragraph, as containing new matter is affirmed.

7. The rejection of claims 5-7, 18, 20, 39-41, 84 and 85 under 35 U.S.C. § 102 as anticipated by Marie is affirmed.

8. The rejection of claims 5-7, 18, 20, 39-41, 84 and 85 under 35 U.S.C. § 103 as being unpatentable over Marie taken with Lechner or Heilmeier in view of Zworykin is affirmed.

9. The rejection of claims 5, 7, 8, 19, 32, 39-41, 43, 48, 49 and 52 under 35 U.S.C. § 102 as anticipated by Jacobson is affirmed.

10. The rejection of claims 5, 7, 8, 10, 19, 32, 39-41, 43, 48, 49 and 52 under 35 U.S.C. § 103 as being unpatentable over Jacobson taken with Lechner or Heilmeier is affirmed with respect to claims 5, 7, 8, 19, 32, 39-41, 43, 48, 49 and 52, but is reversed with respect to claim 10.

11. The rejection of claims 5, 7, 39, 40, 42 and 52 under 35 U.S.C. § 102 as anticipated by Robertson is affirmed with respect to claims 5, 7, 39, 40 and 52, but is reversed with respect to claim 42.

12. The rejection of claims 10, 32, 43, 48 and 49 under 35 U.S.C. § 102 as anticipated by Jacobson, figures 5 and 6 is affirmed with respect to claims 32, 43, 48 and 49, but is reversed with respect to claim 10.

13. The rejection of claims 56, 57, 74 and 75 under 35 U.S.C. § 103 as unpatentable over Robertson in view of Marie, Scheffer, Jacobson and Ernstoff '968 is affirmed with respect to claim 57 but is reversed with respect to claims 56, 74 and 75.

14. The rejection of claims 56, 57, 74 and 75 under 35 U.S.C. § 103 as unpatentable over Robertson, Marie, Scheffer and/or Jacobson in view of Ernstoff '968 is affirmed with respect to claim 57 but is reversed with respect to claims 56, 74 and 75.

15. The rejection of claim 58 under 35 U.S.C. § 103 as unpatentable over Jacobson in view of Marie, Scheffer and Ernstoff '968 is affirmed.

16. The rejection of claim 86 under 35 U.S.C. § 103 as unpatentable over Roth in view of Heilmeier '112 is affirmed.

17. The rejection of claim 38 under 35 U.S.C. § 112, first paragraph, as lacking enablement is affirmed.

18. The rejection of claims 9, 11-15, 17, 22, 24, 28, 33, 44, 59 and 87 under 35 U.S.C. § 103 as unpatentable over Roth in view of Heilmeier '112 and Lechner is affirmed.

19. The rejection of claims 1, 3, 16, 19, 23, 25, 26, 29-31, 34-37, 45-47, 50, 51, 54, 67, 72, 77, 79 and 82 under 35 U.S.C. § 103 as unpatentable over Roth in view of Heilmeier '112, Lechner, Taguchi and Fergason is affirmed.

20. The rejection of claims 4, 55 and 83 under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Heilmeier '112, Taguchi, Fergason and Lechner is affirmed.

21. The rejection of claims 21, 27 and 28 under 35 U.S.C. § 103 as unpatentable over Roth is affirmed.

22. The rejection of claims 52, 61, 68, 76 and 80 under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Lechner is affirmed.

23. The rejection of claims 60, 65 and 69 under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Lechner is affirmed.

24. The rejection of claim 53 under 35 U.S.C. § 103 as unpatentable over Hanlon and Fischer in view of Lechner,

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Taguchi and Fergason is affirmed.

25. The rejection of claims 64 and 67 under 35 U.S.C. § 103 as unpatentable over Hanlon in view of Fischer and Fergason is affirmed.

26. The rejection of claims 62, 66, 71-73 and 77-79 under 35 U.S.C. § 103 as unpatentable over Hanlon, Fischer, Lechner and Fergason is affirmed.

27. The rejection of claims 74, 75, 81, 84, 85 and 88-90 under 35 U.S.C. § 103 as unpatentable over Marie in view of Lechner and Fergason is affirmed.

28. The rejection of claim 2 under 35 U.S.C. § 103 as unpatentable over Lechner in view of de Quervain and Fergason is affirmed.

29. The rejection of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner, de Quervain and Fergason is affirmed.

30. The rejection of claims 3, 9, 11-17, 19, 22-26, 28-40, 42, 44-50, 51, 52, 54, 56, 59, 84, 85 and 87-90 under

the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner, Roth and Heilmeier is affirmed.

31. The rejection of claims 4, 55 and 83 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Hanlon is affirmed.

32. The rejection of claims 5-8, 18, 20, 41, 42, 74, 75, 84 and 85 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Marie is affirmed.

33. The rejection of claims 8 and 43 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Jacobson or Marie is affirmed.

34. The rejection of claim 10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of

Lechner is affirmed.

35. The rejection of claims 21, 27 and 28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Roth is affirmed.

36. The rejection of claims 9, 74, 75, 81, 82 and 88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Lechner and Marie is affirmed.

37. The rejection of claims 52, 57, 58, 64, 67, 68 and 76 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Fischer is affirmed.

38. The rejection of claims 53, 60-63, 65, 66, 69-73 and 77-80 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of Fischer and Lechner is affirmed.

39. The rejection of claim 86 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 in view of

Roth and Heilmeier is affirmed.

40. The rejection of claims 1, 3, 5-11, 15, 18, 20, 41-43, 74, 75, 81, 82, 84, 85 and 88 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie is affirmed.

41. The rejection of claims 1, 3, 5, 7-11, 15, 18, 52, 53, 57, 58, 60-73 and 76-80 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer and Lechner is affirmed.

42. The rejection of claim 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Fischer and Lechner and further in view of de Quervain is affirmed.

43. The rejection of claim 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Marie and further in

view of de Quervain is affirmed.

44. The rejection of claims 4, 55 and 83 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Hanlon is affirmed.

45. The rejection of claims 12-40, 42, 44-52, 54, 56, 59 and 84-90 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 in view of Roth, Lechner and Heilmeier is affirmed.

46. The rejection of claims 1-90 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 12-16 of Hyatt '385 is reversed.

47. The rejection of claims 1-90 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 16 and/or claims 18, 25, 28-30 and 32 of Hyatt '732 is reversed.

48. The rejection of claims 1-90 under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over Hyatt '385 and/or Hyatt '732 is reversed.

Since we have sustained at least one of the rejections of each of appealed claims 1-90, the decision of the examiner rejecting claims 1-90 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Further proceedings in this case may be taken in accordance with 35 U.S.C. §§ 141 to 145 and 306, and 37 CFR §§ 1.301 to 1.304. Note also 37 CFR § 1.197(b). If the patent owner fails to continue prosecution, the reexamination proceeding will be terminated, and a certificate under 35 U.S.C. § 307 and 37 CFR § 1.570 will be issued canceling the patent claims, the rejection of which have been affirmed.

AFFIRMED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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